

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Berstis

§ Group Art Unit: 2178

OCT 02 2007

Serial No.: 10/801,736

§ Examiner: Campbell, Joshua D.

Filed: March 16, 2004

§ Attorney Docket No.: AUS919990100US2

For: Method and Apparatus for
Providing a Central Dictionary and
Glossary Server

§

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

In response to the Notice of Allowance and Issue Fee Due dated July 9, 2007, it is respectfully requested that this Comments on Statement of Reasons for Allowance be entered in the application file of the above-referenced application.

Comments on Statement of Reasons for Allowance

In an Examiner's Amendment accompanying the Notice of Allowance and Issue Fee Due dated July 9, 2007, the Examiner has amended claim 55 to change "A computer program product in a computer-readable medium for use in..." to "A computer program product stored in a computer recordable-type medium for use in..." In commenting on this amendment to claim 55, the Examiner states on page 7 of the Notice of Allowability that the amendments "have been made as a good faith effort to overcome apparent 35 U.S.C. 101 non-statutory issues." The Examiner further states on page 7 of the Notice of Allowability:

"Prior to this amendment, the claimed invention was directed to non-statutory subject matter. These claims are non-statutory for at least the reason that they are not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable storage medium which does not include a carrier wave or other form of transmission medium) due to the definition provided in the specification for computer readable media (page 30, lines 7-10 of applicant's specification). The amendment provided a tangible embodiment which is enabled by the definitions in the specification."

Applicant hereby accepts the above Examiner's Amendment in order to expedite prosecution of this application. However, Applicant respectfully disagrees with the Examiner's assertion that claim 55 was directed to non-statutory subject matter prior to the Examiner's Amendment. In particular, Applicant disagrees with the Examiner's assertion that the claim was non-statutory because it was not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable storage medium which does not include a carrier wave or other form of transmission medium).

Applicant submits that there is no basis for holding a computer program product claim non-statutory because a computer readable medium may be allegedly "intangible." The MPEP states:

In this context, "functional descriptive material" consists of **data structures** and computer programs which **impart functionality when employed as a computer component**. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer

efficiency held statutory) and *Warnerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warnerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). (emphasis added)

MPEP 2106 (IV)(B)(1)

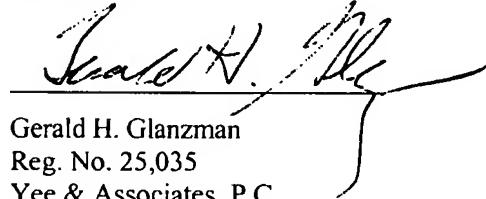
Prior to the Examiner's Amendment, claim 55 recited clearly functional descriptive material since it imparted functionality when employed as a computer component. Moreover, the functional descriptive material of claim 55 was recorded on "some" computer-readable medium.

In the above context, the term "some" means "any" computer-readable medium. The MPEP does not draw any distinctions between one type of media that is considered to be statutory and another type of media that is considered to be non-statutory. To the contrary, the MPEP clearly states that as long as the functional descriptive material is in "some" computer-readable medium, it should be considered statutory.

Thus, Applicant respectfully submits that claim 55 (as well as the claims dependent on claim 55) fully satisfied the requirements of 35 U.S.C. 101 prior to the Examiner's Amendment of the claim.

DATE: August 24, 2007

Respectfully submitted,



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